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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,979	03/23/1999	PHILLIP MERRICK	A007145	9188

23373 7590 09/26/2002

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WASHINGTON, DC 20037

EXAMINER

COURTENAY III, ST JOHN

ART UNIT PAPER NUMBER

2151

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/274,979

Applicant(s)
Merrick et al.

Examiner
St. John Courtenay III

Art Unit
2151



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 12, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-75, 90-101, 110-113, and 125-179 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 90-101 and 145-164 is/are allowed.
- 6) ☒ Claim(s) 70-75, 110-113, 125-144, and 165-179 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

ST. JOHN COURTENAY III
PRIMARY EXAMINER

Detailed Action

As per canceled claims 114—117:

Canceled claims 114—117 are missing from the instant application file wrapper.

Even though Applicant has now canceled these claims, a replacement sheet 80 is still required, as requested in the last office action. Either page 80 was missing as originally filed, or was lost within the PTO.

The scope of surrendered subject matter cannot be ascertained without a complete accounting of ALL claims presented in the instant patent application.

A replacement sheet 80, as originally filed, is required in response to this office action.

Improper claim numbering

The response received 7-12-2002 (Amendment B, paper 12) is not in compliance with 37 CFR § 1.126 - Numbering of Claims

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

Applicant has presented a set of new claims that are incorrectly numbered beginning with new claim 197. However, claim 124 was the last pending claim before entry of the amendment. Accordingly, new claims 197 – 251 have been renumbered by the Legal Instrument Examiner as new claims 125-179, respectively. **Accordingly, claims 70-75, 90-101, 110-113, and 125-179 are now pending.** Applicant's next response must be numbered to agree with the instant patent application file wrapper.

Claim Rejections - 35 U.S.C. § 112, second paragraph

Claims 70-75, 110-113, 125-144, and 165-179 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The **exemplary language**: “e.g., *RECORD and ARRAY*” or “e.g., *Value*” or “e.g., *Record*” or “e.g., *Null or Object*” renders the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention or not, and the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. The use of **exemplary language** “for example” or “such as” was found to be indefinite in the following cases: Ex parte Hall, 83 USPQ 38 (Bd. App. 1949); Ex parte Hasche, 86 USPQ 481 (Bd. App. 1949); Ex parte Steigerwald, 131 USPQ 74 (Bd. APP. 1961).

In general, the use of **exemplary language**: “for example,” “such as,” “... or the like,” or, “for instance, ...” is considered indefinite when recited in claims. The use of **exemplary language** in the claims creates ambiguity. Description of examples or preferences is properly set forth in the specification rather than the claims. Examples and preferences set forth within the body of the claim lead to confusion over the intended scope of the claim.

All claims that depend upon indefinite independent claims also stand rejected under 35 U.S.C. § 112, second paragraph. Appropriate correction is required.

Allowable claims

Claims 90-101, and 145-164 appear to be allowable over the prior art of record, subject to the results of a final search by the Examiner.

RULE 1.105 REQUEST FOR INFORMATION

Applicant and the assignee of this application are required under 37 C.F.R. §1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. SPE authorization has been granted for this RULE 1.105 request.

The information is required to extend the domain of search for prior art. Limited amounts of art related to the claimed subject matter are available within the Office, and are generally found in class 709/330, which describes remote procedure calls. A broader range of art to search is necessary to establish the level of knowledge of those of ordinary skill in the claimed subject matter art of XML as used with remote procedure calls. The information is required to document the level of skill and knowledge in the art of XML as used with remote procedure calls.

- In response to this requirement, please provide the citation and a copy of each publication that any of the applicants relied upon to draft the claimed subject matter. For each publication, please provide a concise explanation or the reliance placed on that publication in distinguishing the claimed subject matter from the prior art.
- In further response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.
- In further response to this requirement, please provide the citation and a copy of each publication which any of the applicants authored or co-authored and which describes the disclosed subject matter of XML as used with remote procedure calls.
- In further response to this requirement, please state the specific improvements of the claimed subject matter in all independent claims over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure that describe the claimed structure and acts.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in Applicant's disclosure.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 C.F.R. §1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be obtained will be accepted as a complete response to the requirement for that item.

37 C.F.R. § 1.105

(a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) Search: Whether a search of the prior art was made, and if so, what was searched.

(iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

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Format of Amended Claims pursuant to 37 C.F.R. 1.121:

37 CFR § 1.121 amendments were optional on November 7, 2000 and became mandatory on March 1, 2001.

• Please help expedite the prosecution of this application by including a clean set of all pending claims, consolidating all previous versions of pending claims from a series of separate amendments into a single clean version in a single amendment paper. This submission of a clean version of all of the pending claims will be construed as directing the cancellation of all previous versions of any pending claims. No marked-up version will be required to accompany the clean version where no changes other than the consolidation are being made. 37 CFR § 1.121.

For details of the PBG final rules please refer to the following PTO website:

<http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>

How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **St. John Courtenay III** whose voice telephone number is (703) 308-5217. A voice mail service is also available at this number.

- All responses sent by U.S. Mail should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

- Hand-delivered responses should be brought to Crystal Park Two, 2021 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

PTO FAX NUMBERS:

- AFTER-FINAL faxes must be signed and sent to: (703) 746-7238.
- OFFICIAL faxes must be signed and sent to: (703) 746-7239.
- NON OFFICIAL faxes should not be signed, please send to: (703) 746-7240, or to Examiner Courtenay's desktop computer at 703-746-5472.

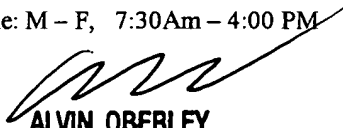
All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.


To avoid ongoing Washington D.C. area mail processing delays, the Examiner requests that Applicant direct all communications to the PTO by fax. All incoming faxes are securely stored on PTO computers that are dedicated to fax reception. If you send a fax, please **do not** send duplicate papers via U.S. mail.

- Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (703) 305-3900.

Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to: **Technical Center 2100 CUSTOMER SERVICE: 703 306-5631**

Normal Flex work schedule: M – F, 7:30Am – 4:00 PM


ALVIN OBERLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100


ST. JOHN COURTENAY III
PRIMARY EXAMINER

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